

The opinion in support of the decision being entered today
is *not* binding precedent of the Board.

UNITED STATES PATENT AND TRADEMARK OFFICE

**BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES**

Ex parte MAY SHANA'A, MICHAEL C. CHENEY,
ROBERT AVENA, KEVIN KEATING,
CRAIG S. SLAVTCHEFF, BRIAN J. DOBKOWSKI,
ROSA PAREDES, MARION L. MARGOSIAK,
CHRISTY BRIDGES, and MARCINA SICILIANO

Appeal 2007-0533
Application 09/930,320
Technology Center 1600

Decided: September 7, 2007

Before DONALD E. ADAMS, ERIC GRIMES, and RICHARD M.
LEBOVITZ, *Administrative Patent Judges*.

GRIMES, *Administrative Patent Judge*.

DECISION ON APPEAL

This is an appeal under 35 U.S.C. § 134 involving claims to a method of providing a customized personal care product, which the Examiner has rejected as obvious. We have jurisdiction under 35 U.S.C. § 6(b). We affirm.

BACKGROUND

The present application was the subject of a previous appeal to this board (Appeal 2005-1428, decided Sept. 29, 2005). In that appeal, we affirmed the Examiner's rejections based on obviousness but designated the affirmances as new grounds of rejection because our reasoning differed from that of the Examiner. Appellants opted to reopen prosecution and amended the claims. The Examiner rejected the amended claims for obviousness and this appeal followed.

DISCUSSION

1. CLAIMS

Claims 1-11 and 13-29 are pending and on appeal. The claims subject to each rejection have not been argued separately and therefore stand or fall together. 37 C.F.R. § 41.37(c)(1)(vii). We will focus on claims 1, 6, and 24, which read as follows:

1. A method for providing a customized, personal care product to a consumer at a location remote from a second location in which a personal care product base composition is prepared, comprising:
 - (a) providing a selection from a plurality of said personal care base compositions;
 - (b) providing a selection from a plurality of variants from a first class of performance agents, each of said variants being delivered in a first vehicle, said first vehicle for each of said variants having at least two ingredients in common with each other, said first vehicle being compatible with a mixture of said personal care base composition and a second class of performance agents different from the first class;
 - (c) providing a selection from a plurality of variants of said second class of a performance agents, each of said variants being delivered in a second vehicle, said second vehicle for each of said variants having at least two ingredients in common with each other;
 - (d) permitting the consumer to select, in any sequence, said at least one personal care base composition; at least one variant from said first class

of performance agents; and at least one variant from said second class of performance agents;

(e) dosing, in a predetermined sequence, the consumer selected personal care base composition and performance agents into a container to form a personal care product; and

(f) mixing said personal care product until the product is uniform; wherein said first and second class of performance agents are independently selected from fragrances, colorants, benefit agents and blends thereof; and

(g) wherein said first and second class of performance agents do not include a thickener component other than component(s) selected from botanical extracts, emollients, vegetable oils, active agents for treating or preventing skin disorders, vitamins, fragrances and colorants.

6. The method of claim 1 wherein a customized label is applied to the container identifying the product and only the components of the base formula and dosed performance agents contained therein.

24. The method of claim 22 wherein said container has a neck; a cap without an orifice is used to cap said container to improve mixing efficiency when said container's contents are blended by a mixing device while said container is situated in a position substantially inverted from its filling position.

Claim 1 reads the same as it did in Appeal 2005-1428 except for the addition of clause (g): the first and second classes of performance agents do not include thickeners that are not also in one of several specific classes of performance agents (botanical extracts, emollients, etc.).

Claim 6 depends on claim 1 and adds the limitation that a label is applied to the container that identifies the components of the personal care composition. Claim 24 also depends (indirectly) on claim 1 and defines the size and configuration of the container.

2. PRIOR ART

The Examiner relies on the following references:

Tartaglione	US 4,851,062	Jul. 25, 1989
Rigg	US 5,622,692	Apr. 22, 1997
Stewart	WO 98/30189	Jul. 16, 1998
Rath	US 5,972,322	Oct. 26, 1999

3. REJECTION BASED ON RATH AND STEWART

Claims 1-5, 7-11, 13-19, 22, and 25-29 stand rejected under 35 U.S.C. § 103 as obvious in view of Rath and Stewart. As noted above, the claims subject to this rejection stand or fall with claim 1.

We previously held that Rath, by itself, would have made obvious the method defined by claim 1 as it stood in Appeal 2005-1428. The issue, then, is whether the addition of clause (g) to the claim distinguishes the claimed method from the prior art.

We conclude that it does not. Clause (g) of claim 1 states that the performance agents selected by a consumer and added to a personal care base composition “do not include a thickener component other than component(s) selected from” specific classes of performance agents. We held in Appeal 2005-1428 that

Rath would have made obvious to a person of ordinary skill in the art a hair care system comprising a plurality of base compositions (e.g., shampoo base and conditioner base), a thickener, and a plurality of performance agents selected from at least *two classes of performance agents* (e.g., the two *herbal additive compositions* in columns 19-20 and two or more of the *color concentrates* in columns 20-23). According to Rath’s disclosure, the user would select the desired additives, combine them with the appropriate base (shampoo base for making

shampoo, conditioner base for making conditioner) and mix, then add thickener and mix again.

(Appeal 2005-1428 Decision, p. 6, emphases added.) That is, Rath would have made it obvious to choose from among herbal additive performance agents and to choose from among colorants, add the chosen herbal additive and colorant to a base composition, mix, add thickener, and mix again to yield the desired personal care composition.

Rath suggests the method of claim 1 even when the thickener is not considered a performance agent. We addressed this point specifically in Appeal 2005-1428:

We agree with Appellants that the specification defines a thickener as a possible constituent of the base composition, not a performance agent or (in Rath's terms) an enhancing additive. We do not see how that issue affects the outcome of the analysis, however. Even if Rath's thickener is considered a part of the base and not an enhancing additive, the method suggested by Rath meets all of the limitations of instant claim 1.

(Appeal 2005-1428 Decision, p. 8.) The clause added by amendment to claim 1 changes nothing about this analysis: Rath suggests herbal additives and colorants as first and second classes of performance agents, and therefore meets the limitations of claim 1 regardless of whether the thickener component itself is considered a performance agent.

Appellants argue that Rath teaches away from a process in which the thickener is part of the base composition (Br. 6-7) and that the "consumer is not intended to be involved in the packaging of the kits disclosed in Rath, et al., but only in the possible mixing of certain kit components" (*id.* at 7).

These arguments were made in Appeal 2005-1428 and are addressed in the decision of that appeal (pages 6-7).

Appellants also argue that “Claim 1 has been further amended responsive to the Board’s decision . . . to explicitly exclude thickening agents that are not defined as performance agents as defined in the specification and to further distinguish the instant invention from Rath, et al.” (Br. 7). However, for the reasons discussed above, we conclude that the amendment to claim 1 does not distinguish the claimed method from that disclosed by Rath. The rejection of claim 1 as obvious in view of Rath and Stewart is affirmed. Claims 2-5, 7-11, 13-19, 22, and 25-29 fall with claim 1.

4. REJECTION OF CLAIMS 6, 20, AND 21

Claims 6, 20, and 21 stand rejected under 35 U.S.C. § 103 as obvious in view of Rath, Stewart, and Rigg. As discussed above, claim 6 adds to claim 1 the requirement that a label is affixed to the container that identifies the components of the composition. The Examiner relies on Rigg for teaching “a customized cosmetic composition in a container having a bar code label for identifying the customized composition” (Answer 7).

We agree with the Examiner that the cited references support a prima facie case of obviousness. The only limitations added by claim 6 to claim 1 relate to the contents of a printed label. However, where the difference between a claimed invention and the prior art consists of the content of printed matter, the printed matter must create a “new and unobvious functional relationship” in order to patentably distinguish the claimed product from the prior art. *See In re Ngai*, 367 F.3d 1336, 1338 (Fed. Cir.

2004) (adding printed instructions describing a new use for a kit composed of old materials did not distinguish the claimed kit from the prior art). No such relationship is created by the label defined by claim 6.

Appellants' only argument with respect to this rejection is that Rigg "does not disclose or suggest the vehicle of each additive to have at least two ingredients in common" (Br. 9). That limitation, however, is disclosed by Rath. We affirm the rejection of claim 6 as obvious in view of Rath, Stewart, and Rigg. Claims 20 and 21 fall with claim 6.

5. REJECTION OF CLAIMS 23 AND 24

Claims 23 and 24 stand rejected under 35 U.S.C. § 103 as obvious in view of Rath, Stewart, Rigg, and Tartaglione. As discussed above, claim 24 limits the size and configuration of the container used in the method of claim 1.

We affirmed the rejection of claim 24 over the same references in Appeal 2005-1428 (Appeal 2005-1428 Decision, pp. 8-9). The only issue, then, is whether the amendment to claim 1 distinguishes the claimed method from that suggested by the references. For the same reasons discussed above with respect to claim 1, we conclude that it does not.

Appellants argue that

Tartaglione does not disclose how personal care products can be custom formulated nor the relationship of the ingredients that are required by the inventive method of custom formulating such products. There would be no motivation to one skilled in the art to combine Rath, et al., with Rigg, et al., and Stewart in further view of Tartaglione to obtain the invention of claims 23 and 24 absent impermissible hindsight of Appellant's [sic] invention.

(Br. 9.)

These arguments are unpersuasive. Custom formulation of personal care products is taught by Rath, and the issue of motivation-to-combine is addressed in our discussion of this rejection in the decision in Appeal 2005-1428. The rejection of claim 24 is affirmed. Claim 23 falls with claim 24.

No time period for taking any subsequent action in connection with this appeal may be extended under 37 C.F.R. § 1.136(a).

AFFIRMED

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